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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,354	02/14/2005	Koichi Goto	450100-05121	6316
7590 William S Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151		08/31/2010	EXAMINER KARIML PEGEMAN	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 08/31/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,354

Applicant(s)

GOTO ET AL.

Examiner

PEGEMAN KARIMI

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 07/28/2010 has been entered and considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-6, and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beernink (U.S. Patent No. 5,434,929) in view of Nishibori (U.S. Patent No. 5,977,948).

As to claims 1 and 11, Beernink teaches an input method using a touch panel input apparatus (10) in which

a touch panel (52 and 24') is laminated onto a display screen (72) of a display apparatus (50), (col. 5, lines 61-64),

a sensor unit (72) is formed so as to be expanded to the outside of one side of said display screen (i.e. 72 includes display screen 52 and keypad 24'. Keypad 24' is arranged outside of the side screen 52), (col. 4, lines 36-39)

an instruction (pop-up window of command icon) according to a touching position of a finger or a touch pen (38) onto said sensor unit is given (col.7, lines 39-47), and

a controller (18) generates a control signal on the basis of said instruction (col. 4, lines 1-2),

comprising the steps of:

displaying a selection display (76) comprising:

Beernink does not specifically mention highlighting said selection items when the finger or the touch pen is near said selection items as the finger or touch pen remains in contact with said sensor unit after the initial touch and is moved along said side on said sensor unit.

Nishibori does not mention *a finger or a touch pen* initially touched and remains in contact with said sensor unit, however, Beernink teaches a touch pen 38, which can be used to move the cursor on the screen instead of the mouse of Nishibori. Therefore since the mouse button is pressed and cursor is moved from one item on the hierarchy menu to another item on the hierarchy menu and also to move from a higher hierarchy menu to a lower hierarchy menu while the mouse button is pressed, it can be concluded that when the touch pen is controlling the cursor in order for the cursor to move from one item on the hierarch menu to another item the stylus must remain in contact with the sensor unit.

Nishibori teaches a plurality of selection items (selection items within the hierarchy menu) along said side of said display screen (col. 4, lines 3-7), (the menu is displayed on a side of the display screen because hierarchy menu starts on the left hand side of the screen and the lowest hierarchy menu is on the right side of the display therefore the highest hierarchy menu should be along one side of the display), when the finger or the touch pen is initially touched and remains in contact with said sensor unit (the cursor is shifted while pressing the mouse button until the cursor is positioned on the menu item);

highlighting said selection items when the finger or the touch pen is near said selection items (as can be seen in Fig. 16 the selected selection items of hierarchy menus are being highlighted as the cursor selects those items) as the finger or touch pen remains in contact with said sensor unit after the initial touch (cursor is shifted while pressing the mouse button) and is moved along said side (the cursor moves along the hierarchy menu 41, which is parallel to the side of the display) on said sensor unit (the cursor is shifted while pressing the mouse button until the cursor is positioned on the menu item, when the menu item is pointed by the cursor a second menu is displayed and the cursor is moved to the second hierarchy menu while pressing the mouse, col. 7, lines 26-35);

selecting said highlighted selection item (i.e. selected item "seeing", Fig. 16) upon lifting the finger or the touch pen from contact with said sensor unit (col. 7, lines 41-47) at the position of the highlighted selection item (i.e. "seeing") after being moved along said side on said sensor unit (after the user moves the cursor along the side of

the hierarchy menu 41 on the screen to chose the item selection "recognize" then the menu item "seeing" is being highlighted and chosen once the user releases the button on the mouse); and

cancelling a selection display (cancelling the selection display of a hierarchy menu) when the finger or the touch pen remains in contact (moving the cursor away from all of the menus and then releasing the mouse button) while being moved from said sensor unit to said display screen on said touch panel (moving the cursor away from the menus would move the cursor into the display screen, this would close all of the menus, col. 7, lines 54-57),

wherein a single touch (pressing the button on mouse), move (cursor being shifted), and release contact (release of the mouse button) operation of the finger or the touch pen (input device controlling a cursor) with the sensor unit (hierarchy menu) executes a combined operation (a) to display the selection display (by moving the cursor on the hierarchy menu 41 a second menu displaying a display selection 42 is displayed while pressing the mouse) and (b) to select a desired selection item in the selection display (desired selection items such as "SEEING", "Seeing", or "seeing" could be selected when the user releases the button at the position of the menu item, (col. 7, lines 26-31 and 41-47). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the hierarchy menus being selected by moving a cursor on the selection item while the mouse button is pressed of Nishibori to the touch panel device of Beernink because the user can easily and faster maneuver between multiple hierarchy menus and find desired information faster through

multiple menus wherein the user does not need to click on each hierarchy menu in order to progress into the next menu.

As to claims 5 and 12, these claim differs from claim 1 only in that the limitations "a controller to which an instruction according to a touching position of a finger or touch pen onto said sensor unit is given".

Claims 5 and 12 also differ in the term "cancelling" and "closing" a selection display, which are both thought by the prior art reference of Nishibori. The cancelling or closing the selection display (desired selection items with in an hierarchy menu) is when the user moves the cursor from lower hierarchy menu to a higher hierarchy menu or releases the mouse button/ lifting the finger/stylus, (col. 7, lines 50-56).

Beernink teaches a controller (18) to which an instruction (pop-up window of command icon) according to a touching position of a finger or touch pen (38) onto said sensor unit is given (col. 7, lines 39-47), (the display assembly 20 of pen-based computer system 10 is both an input and an output device and is coupled to I/O circuitry 18 by a bi-directional data bus 37, also when the buttons are selected by engaging the touch pen 38 the pressure is sensed and communicated to CPU 12 via data bus 37 and I/O 18, Fig. 1).

As to claims 2 and 6, Beernink teaches, operating a predetermined button (64) on a display/sensor unit of said touch panel (24') overlapped with said display screen (24' overlaps 72), an instruction corresponding to said button is generated (col. 5, lines 23-27 and col. 7, lines 39-42).

As to claims 4 and 8, Beernink teaches the selection display is a menu display (col. 7, lines 45-47).

As to claim 9 and 10, Beernink teaches a selection operation is cancelled (quitting a session setting preference) and said selection display is continued when the finger or the touch pen is moved along said sensor unit to an end area of said sensor unit out of range of said selection items on said display screen (when the pen is moved to the close box 94, which is out of range of the selection items of the display screen and is at the end of the sensor unit, the user can select the close box 94 by tapping on the close box to quit a session setting preference and continue working on the display) and thereafter lifting up the finger or touch pen from said sensor unit to said display screen side (the tapping of the close box 94 requires the user to press the pen on the close box and then lift the pen in order to select the close box 94), (col. 9, lines 15-19).

As to claim 13, Beernink teaches the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66) is larger than the display screen (the display area is the area 20).

As to claim 14, Beernink teaches the touch panel (areas 20 and 24' combined) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 15, Beernink teaches the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66) is larger than the display screen (the display area is the area 20).

As to claim 16, Beernink teaches the touch panel (areas 20 and 24' combined) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 17, Beernink teaches the step of providing the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66, the touch panel 20 can be used as an input device by using a stylus 38, therefore the area 20 can be part of the touch panel) to be larger than the display screen (the display area is the area 20).

As to claim 18, Beernink teaches the step of providing the touch panel (areas 20 and 24' combined are the touch panel area because the area 20 can be used as an input device using the stylus 38) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 19, Beernink teaches the step of providing the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66, the touch panel 20 can be used as an input device by using a stylus 38, therefore the area 20 can be part of the touch panel) to be larger than the display screen (the display area is the area 20).

As to claim 20, Beernink teaches the step of providing the touch panel (areas 20 and 24' combined are the touch panel area because the area 20 can be used as an input device using the stylus 38) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

Response to Arguments

4. Applicant's arguments filed 07/28/2010 have been fully considered but they are not persuasive.

Applicant argues that nothing in Beernink teaches or suggests (1) displaying a selection display when a finger or touch pen is initially touched and remains in contact with a sensor unit and (2) a combined operation to display a selection display and to select a desired selection item in the selection display are executed by a single touch, move/slide and release contact operation of the finger or touch pen with the sensor unit as claimed in claims 1, 5, 11, and 12.

Examiner would like to point out that the reference of Nishibori teaches a cursor is shifted while pressing the mouse button until the cursor is positioned on the menu item "recognize", wherein by placing the cursor on the menu item a second hierarchy menu opens up. The cursor is moved to the second hierarchy menu while pressing the mouse. When the cursor is in the second hierarchy menu with the mouse in the pressed condition the cursor is shifted to the position of a menu item "scratch", next the third hierarchy menu is displayed. When the user reaches the desired selection (e.g. seeing) if the mouse button is released the menu item "seeing" which the cursor is now positioned will be considered to be the character for input. This feature of Nishibori is added to the display of Beernink.

Applicant argues that nothing in Beernink shows, teaches, or suggests selecting a highlighted selection item upon lifting a finger or touch pen from contact with the

sensor unit at the position of the highlighted selection item after being moved along a side of the sensor unit as claimed in claims 1, 5, 11, and 12.

Examiner in the previous office action has mentioned that Nishibori teaches selecting a highlighted selection item upon lifting a finger or touch pen from contact with the sensor unit at the position of the highlighted selection item after being moved along a side of the sensor unit, wherein Nishibori teaches selecting an item by releasing the mouse button when the cursor points out the word "seeing" in the menu 44. As can be seen in Fig. 15 the chosen item of "seeing" is highlighted. Also, after the user moves the cursor along the side of the hierarchy menu 41 on the screen to chose the item selection "recognize" then the menu item "seeing" is being highlighted and chosen one the user releases the button on the mouse.

Applicant argues that Nishibori does not teach or show (a) a touch panel input apparatus which is touched by a finger or touch pen or (b) executing a combined operation to display a selection display and to select a desired selection item in the selection display by a single touch, move/slide and release contact operation of a finger or touch pen with a sensor unit as claimed in claims 1, 5, and 11-12.

Nishibori does not mention using a pen or finger to highlight or choose menu selections. On the other hand, Beernink teaches a touch pen 38, which can be used to move the cursor on the screen instead of the mouse of Nishibori. The release of the mouse button could be interpreted as lifting the pen or finger from the display of Beernink.

Nishibori teaches displaying a selection display, which is displaying the menus 41-45 on the screen, which each menu has a selection item and is displayed on a screen. The user may select a desired selection item on the display screen when a cursor is shifted while pressing the mouse button until the cursor is positioned on the menu item "recognize", wherein by placing the cursor on the menu item a second hierarchy menu opens up. The cursor is moved to the second hierarchy menu while pressing the mouse. When the cursor is in the second hierarchy menu with the mouse in the pressed condition the cursor is shifted to the position of a menu item "scratch", next the third hierarchy menu is displayed. When the user reaches the desired selection (e.g. seeing) if the mouse button is released the menu item "seeing" which the cursor is now positioned will be considered to be the character for input.

Applicant argues that Examiner is using hindsight to combine Beernink and Nishibori. Wherein Applicant submits that the combination of Beernink and Nishibori is not possible since Beernink clearly teaches any movement would cause drawing of a figure on the screen and only tapping is used to select an item and the technologies of Beernink using a touch pen for tapping and writing on a screen is completely different from a virtual cursor moved by a mouse as touch by Nishibori. Applicant further argues that the examiner is only selecting bits and pieces of the references without considering the remaining teachings of those references which would lead away from the claimed invention.

Examiner respectfully disagrees with the applicant. Both references refer to a display having menu items and selecting these menu items. In Beernink the selection

method is by tapping an icon or menu, which is by placing the stylus on the screen for a short, predetermined length of time and then lifting the stylus without moving the stylus a significant amount. The prior art reference of Nishibori teaches clicking on the mouse button and moving the cursor on the screen while the mouse button is pressed, this would allow the user to move from menu to menu and when the user is ready to select an item from the menu then the user lifts his/her finger from the mouse button and the highlighted item is selected. Nishibori teaches pressing and lifting the finger from the mouse button in order to select a highlighted item on the menu, which could be considered similar to Beernink's tapping, however, Nishibori teaches dragging a cursor on the screen while the mouse button is pressed in order to open the menus and move from one menu to another menu because the user can easily and faster maneuver between multiple hierarchy menus and find desired information faster through multiple menus wherein the user does not need to click or tap on each hierarchy menu in order to progress into the next menu. Accordingly, the two references are not distinct from each other and the prior art reference of Nishibori teaches a process of tapping plus being able to drag through the menus while the mouse button is pressed, which is similar to the pen being in contact with the screen.

Applicant nowhere in the claimed invention mentions movement of the stylus or finger does not draw a figure on the screen. Examiner would like to also add that in Nishibori when the user is dragging the cursor on the screen while the mouse button is being pressed the cursor does not draw any figures.

Examiner respectfully disagrees with the applicant's interpretation of "examiner is only selecting bits and pieces of the references without considering the remaining teachings of those references which would lead away from the claimed invention".

The advantage of prior art reference of Nishibori is being used to teach the limitations not taught or mentioned by Beernink. The two references of Beernink and Nishibori teach the limitations of the claimed invention.

Applicant argues the any movement of the stylus 38 of Beernink would correspond to drawing an image on a screen. Examiner as mentioned above in the arguments would like to point out that applicant no where in the claimed invention mentions movement of the stylus or finger does not draw a figure on the screen and in Nishibori when the user is dragging the cursor on the screen while the mouse button is being pressed the cursor does not draw any figures.

Applicant further argues that Nishibori uses a virtual cursor moved via a mouse and is unrelated to a touch panel input apparatus. Beernink teaches a touch pen 38, which can be used to move the cursor on the screen instead of the mouse of Nishibori. Therefore since the mouse button is pressed and cursor is moved from one item on the hierarchy menu to another item on the hierarchy menu and also to move from a higher hierarchy menu to a lower hierarchy menu while the mouse button is pressed, it can be concluded that when the touch pen is controlling the cursor in order for the cursor to move from one item on the hierarch menu to another item the stylus must remain in contact with the sensor unit.

Applicant argues that nothing in the combination of the references shows, teaches, or suggests (1) displaying a selection display when a finger or touch pen is initially touched and remains in contact with a sensor unit (2) a combination to display a selection display and to select a desired selection item in the selection display are executed by a single touch, move/slide and release contact operation of a finger or touch pen with a sensor unit of a touch panel and (3) selecting a highlighted selection item upon lifting the finger or touch pen from contact with the sensor unit at the position of the highlighted selection item after being moved along the side on the sensor unit as claimed in claims 1, 5, 11, and 12.

Examiner has addressed the above (1), (2), and (3) arguments above in the claims and response to arguments. The combination of the two references of Beermink and Nishibori teaches all of the applicant's claimed invention.

Examiner has also added newly found references that are not relied upon, but considered pertinent to applicant's disclosure

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Smith (U.S. Patent No. 5,721,853) teaches when the mouse pointer 23 is moved over the spot GDE 10, a collar 200 of the spot interface is immediately displayed. This displaying of the collar 200 occurs without the user's having to click on any element of the spot interface using the mouse 22; rather, simply moving the pointer into the area defined by the GDE 10 will cause the collar 200 to be displayed.

Salesin (U.S. Pub. No. 2003/0229845) teaches Hovering over an area of manifold content with an input device such as a mouse pointer brings up a small menu 804 with several editing choices.

Bier (U.S. Patent No. 5,581,670) teaches placing a cursor at a particular location in a word processor image may operate to insert typed text at that location. Dragging the cursor over a portion of the displayed text may select the text (shown on the screen as highlighted) so that the user can apply an operation (such as deleting, moving, or changing the font) to the selected text by some other mechanism.

Inquiry

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGEMAN KARIMI whose telephone number is (571)270-1712. The examiner can normally be reached on Monday-Thursday 9:00am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/
Examiner, Art Unit 2629
August 17, 2010

/Chanh Nguyen/
Supervisory Patent Examiner, Art
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